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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,456	12/08/2003	Robert G. Metzger	5490-000317	2923
27572	7590	10/13/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C.			SWIGER III, JAMES L	
P.O. BOX 828			ART UNIT	
BLOOMFIELD HILLS, MI 48303			PAPER NUMBER	
			3733	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/730,456	Applicant(s) METZGER ET AL.	
	Examiner James L. Swiger	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 13-21, 23 and 28-31 is/are rejected.
- 7) ☒ Claim(s) 6-7, 11-12, and 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments filed 7/24/2006 have been fully considered but they are not persuasive.

With regards to the amendment of claim 1 adding a first actuator that is disposed between the extension and the base portion, configured (a functional limitation) to rotatably displace the extension, it is noted that this limitation was previously rejected in claim 9 under Hodge and still meets the claim limitation.

Though it is deemed persuasive that Axelson Jr. et al. does not specifically disclose a "worm gear" it does nevertheless disclose a gear. Claim limitations as amended for 30-31 and also 16-18 and 20 are anticipated by the Axelson, Jr. et al. reference. The allowability of claim 17 has been withdrawn. Also with regards to the Axelson reference not having skids, it is held that the reference meets the claim limitation of the claim because "configured" is considered a functional limitation of the claim, still meeting structure, whether or not the device may be used for a tibia as well.

Further with regards to the arguments for Harwin regarding the knob that specifically "locks" in Col. 5, lines 47-50, the knob may still function as an actuator *prior* to the locking.

And finally, with regards to the arguments that a "gear" is required to be rotationally displaced, it is held that the gear of at least Axelson Jr, et al., including portion 18, includes axial displacement of the extension, and at least portion 18 has radial displacement.

In light of the above reasons, the following rejections still apply:

***Claim Rejections - 35 USC § 112***

Claims 9 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims 9 and 29 positively claim a *second* actuator and the written disclosure claims only *one* actuator.

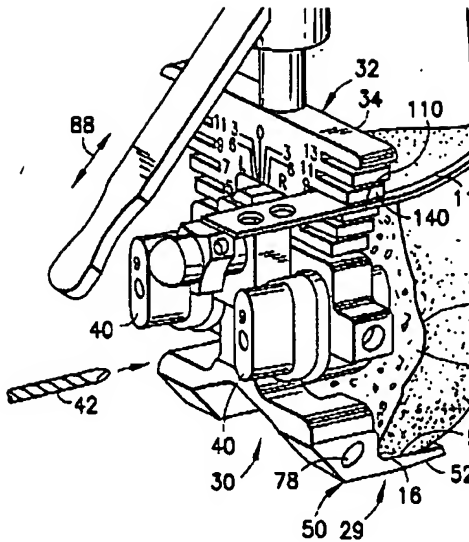
***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-4, 8, 21-24, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Harwin et al. (US 6,458,135). Harwin et al. disclose a femoral guide having an extension portion (30) configured to be adjacent to a posterior condyle surface of the femur, a base portion (32), a superstructure (90), and a graduated stylus (80) that is configured to be adjacent to the anterior condyle surface of the femur. Harwin et al. further disclose a device with a pair of feet (52, the second foot hidden in Fig. 3), the extension is rotably coupled to the base (See Fig. 3 below).



Further, the device of Harwin et al. disclose a slot to restrain the movement of the stylus (96) that is also capable of being along the transepicondylar axis of the femur (Col. 2, line 38), that is capable of being rotably coupled and is substantially parallel.

Claims 16-18, 20, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Axelson, Jr. et al. (US 5,860,980). Axelson, Jr. et al. disclose a surgical apparatus for knee surgery capable of use on a femur comprising a base portion (20) with a first coupling mechanism (36), a fixed first foot portion (38) coupled to the first, a second foot portion (22 and 24) coupled to a third coupling mechanism (26), and a superstructure (16) slidably coupled to the base (via item 33). The feet are *capable* of being positioned adjacent to the posterior condyle surface of the femur, and the second rotatable foot portion comprises a gear (18) that is capable of yielding rotation with its slidable attachment with the superstructure. It is also a predetermined distance from the rotational axis (See fig. 1).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwin et al. in view of Muller (US Pub 2001/0018589). Harwin et al. disclose the claimed invention except for a worm gear, or at least a gear that is disposed between the base and extension portion that is capable of causing rotation of the feet with respect to the superstructure, base, and extension. Muller discloses an apparatus that has a worm gear (Par. 0044) that may rotate with respect to the superstructure, base and extension. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Harwin et al. having at least a worm gear that may angle with respect to the extension, base and feet in view of Muller to better fit the condylar portion of the femur.

Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwin et al. '135 in view of Hodge (US 5,486,178). Harwin et al. disclose the claimed invention except for an actuator capable of disposing the superstructure with respect to the base. Hodge discloses an actuator (60) that is considered to move the two pieces together, and Hodge also has a superstructure (80) and base (82), and see Col. 4, lines 22-32. Also for further clarification see item 54. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the

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device of Harwin et al. having at least an actuator to allow translation between the superstructure and base in view of Hodge to better configure the device in preparation for sizing the femur.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Axelson, Jr. et al. '980 in view of Hodge '178. Axelson Jr., et al. disclose the claimed invention except for an actuator capable of disposing the superstructure with respect to the base. Hodge discloses an actuator (60) that is considered to move the two pieces together, and Hodge also has a superstructure (80) and base (82), and see Col. 4, lines 22-32. Also for further clarification see item 54. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Axelson, Jr., et al. having at least an actuator to allow translation between the superstructure and base in view of Hodge to better configure the device in preparation for sizing the femur.

#### ***Allowable Subject Matter***

The allowability of claim 17 has been withdrawn.

Claims 6-7, 11-12, and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



10/9/02

JLS



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SUPERVISORY PATENT EXAMINER